

Appl. No : 10/611,321
Filed : July 1, 2003

REMARKS

With this Amendment, Claims 1-6, 13 and 17-21 are pending in the present application, Claims 7-12 and 14-16 having been canceled without prejudice, Claims 1, 4-6 and 13 having been amended, and new Claims 17-21 having been added. No new matter is being entered by the above amendments. Applicant reserves the right to pursue the subject matter of the canceled claims in subsequent continuing applications.

Anticipation and Obviousness

Claims 1, 3-10, 12, 13 and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Feingold et al., and Claims 11, 14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Feingold in view of Hidvegi. Applicant notes that the rejections of Claims 4-12 and 14-16 are moot in view of their cancellation. Claim 1 has been amended to recite the limitations of Claim 11 and intervening dependent claims as well as some additional limitations. In view of the above amendments and the following remarks, Applicant respectfully submits that Claims 1-3 and 13 recite unique combinations of features that are not taught or suggested by the prior art of record either alone or in combination.

With reference to Claims 11, 14 and 16, the Examiner asserted that the Hidvegi patent discloses a set of “tiles”, each having a plurality of faces. The Examiner further asserted that each “tile” has a pattern and color printed on each of its different faces and that the “tiles” are arranged in different designs. The Examiner concludes that, in view of these teachings, it would have been obvious to an ordinarily skilled artisan to incorporate a reverse color scheme to the second face of Feingold’s tiles.

Applicant traverses the rejection and respectfully disagrees with the Examiner’s characterization of the cited references. Furthermore, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness. Establishment of a *prima facie* case of obviousness requires, among other things, that the prior art references teach or suggest all of the claim limitations.

The Hidvegi patent teaches a number of “elements” i.e. blocks or tiles with a variety of shapes in a variety of colors. In particular, Figures 13 and 14 of Hidvegi illustrate cubic blocks having six faces each. Nonetheless, Hidvegi lacks any specific teaching of a two-sided tile in which the pattern on the first side is identical to and bears a reversed color

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scheme to the pattern on the second side. Without such a teaching in the prior art, a *prima facie* case of obviousness with respect to the limitations of original Claim 11 cannot be established.

At best, the rejection as stated amounts to an assertion that a person having ordinary skill may have found it obvious to try to modify the teachings of Feingold to obtain “different designs” as suggested by Hidvegi. However, such a suggestion is insufficient to render obvious the unique combination of limitations recited in amended Claim 1. An “obvious to try” rationale is an improper basis for an obviousness rejection in the absence of any suggestion in the prior art of the claimed result or any indication of how one would achieve such a result.

Moreover, even if Feingold and Hidvegi were combined, the invention recited in Claim 1 would not result, since there is no suggestion in the prior art to modify the teachings of Feingold in the manner suggested by the Examiner. For at least the above reasons, Applicant respectfully requests that the rejection of Claim 1 be withdrawn. Additionally, dependent Claims 2-6 recite additional combinations of limitations which are also not taught or suggested by the prior art of record either alone or in combination, and Applicant requests that the rejections of these claims be withdrawn as well.

Furthermore, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to Applicant’s amended Claim 13. In addition, Applicant respectfully submits that the prior art of record does not teach or suggest a tile comprising “a thin flat sheet, substantially square in plan aspect, and having exactly two faces” in which “the corners intersected by the first arc on the first face are the same corners as those intersected by the second arc on the second face” and “wherein the first region comprises a first color and the second region comprises a second color, and the colors on the first face are the inverse of the colors on the second face.”

Moreover, even if Feingold and Hidvegi were combined, the invention recited in Claim 13 would not result, since there is no suggestion in the prior art to modify the teachings of Feingold or Hidvegi in order to achieve the unique combination of limitations recited in Claim 13. For at least these reasons, Applicant respectfully requests that the

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rejection of Claim 11 be withdrawn. Additionally, Applicant respectfully submits that Claims 17-21 are also in condition for allowance.

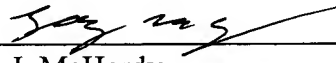
CONCLUSION

The undersigned has made a good faith effort to respond to all of the rejections and objections in the present application and to place the claims into condition for allowance. Nevertheless, if any issues remain which can be resolved by telephone, the Examiner is respectfully requested to call Applicant's representative at the number indicated below in order to resolve such issues promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10/7/04

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